



B

520.30414V22

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: KATO, et al.

Application No.: 09/766,596

Filed: January 23, 2001

For: VACUUM PROCESSING APPARATUS AND OPERATING  
METHOD THEREFOR

Group: 3749

**PETITION FOR WITHDRAWING ANY POSSIBLE ABANDONMENT OF THE ABOVE-  
IDENTIFIED AND TO ISSUE A NEW NOTICE OF ALLOWANCE AND FEE(s) DUE  
WITH A CORRECT MAILING ADDRESS AND CORRECT CUSTOMER NUMBER**

Mail Stop Petitions  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

September 12, 2003

Sir:

The telephone communication from Examiner Wilson on or about September 4, 2003, in connection with the above-identified application, is noted. During this telephone communication, the Examiner referred to a Notice of Allowance and Fee(s) Due mailed December 18, 2001, in connection with the above-identified application; and that apparently this Notice of Allowance and Fee(s) Due mailed December 18, 2001 had never been responded to. The Examiner is thanked for this telephone communication.

In view of this telephone communication, the undersigned requested that the Examiner transmit a copy of the Notice of Allowance and Fee(s) Due mailed

December 18, 2001, to the offices of the undersigned, for an investigation as to whether such Notice of Allowance and Fee(s) Due mailed December 18, 2001 was ever received in the offices of the undersigned. The Examiner cooperated with this request, sending a copy of this Notice of Allowance mailed December 18, 2001, to the offices of the undersigned by facsimile.

As will be established in the following, it is respectfully submitted that an original mailing of this Notice of Allowance and Fee(s) Due mailed December 18, 2001, was never received in the offices of the undersigned attorneys; and, moreover, that a Notice of Abandonment was never received in the offices of the undersigned. This is clearly supported by the incorrect mailing name and address set forth on the Notice of Allowance and Fee(s) Due mailed December 18, 2001, transmitted to the following:

Mitchell P Brook  
c/o Baker & McKenzie  
101 Broadway  
Suite 1200  
San Diego, CA 92101,

as well as the incorrect customer service no. (024057, as compared with the correct customer service no. of 240457) on this Notice of Allowance mailed December 18, 2001.

Accordingly, pursuant to Manual of Patent Examining Procedure (MPEP) § 711.02 and the Commissioner's notice in 1156 OG 53, it is respectfully petitioned that any possible holding of abandonment be withdrawn and that a new Notice of Allowance and Fee(s) Due be mailed in connection with the above-identified application, after consideration of the various papers filed in the above-identified application after May

29, 2001 (that is, amendments to the claims as in the Further Supplemental Preliminary Amendment filed January 14, 2002 and in the Supplementing Preliminary Amendment filed March 13, 2003; and the documents submitted in the Information Disclosure Statements respectively submitted February 6, 2002, July 15, 2002 and February 20, 2003).

It is respectfully submitted that issuance of a new Notice of Allowance, after consideration of the above-referred-to papers, is mandated based on the rationale set forth in Delgar, Inc. v. Schuyler, 172 USPQ 513 (DDC 1971).

It is respectfully submitted that the incorrect firm name and address, and incorrect customer service number, on the Notice of Allowance mailed December 18, 2001, provides sufficient basis for the conclusion that this Notice of Allowance mailed December 18, 2001, was not received in the offices of the undersigned. Moreover, as for additional reasons for granting this Petition, the following facts are respectfully submitted.

In the offices of the undersigned attorneys, all mail which is received from the U.S. Patent and Trademark Office (PTO) is given directly to a docketing department. Responsive to receipt of such mail, as a first safeguard, the docketing department maintains a computer database which stores information relating to the filing of papers in the PTO, receipt of papers from the PTO, and due dates for responding to papers received from the PTO. The data in the computer database is backed up on a magnetic tape at the end of each work day.

Attached hereto is a printout of pertinent data in the computer database for the present application. The attached printout shows data fields entitled "Action", "Base", "Due In", "Due", "Final", and "Response" which will be discussed below.

When a paper which must be responded to is received from the PTO, the docketing department enters the mailing date of such paper in the "Base" data field. The description of the paper is set forth in the "Action" data field, and would be "Issue Fee" if the paper is a Notice of Allowance. The "Due" data field is the period for response, the "Final" data field being the final date for response; for the Issue Fee, the same date would normally be set forth for both the "Due" data field and "Final" data field, in view of the 3-month non-extendable period.

As can be seen in the enclosed computer printout for the above-identified application, there are a number of indications that various papers have been filed, including a Supplementing Preliminary Amendment on March 13, 2003; an Information Disclosure Statement (IDS) filed February 20, 2003; an IDS filed July 16, 2002; an IDS filed February 6, 2002; a Supplemental Preliminary Amendment filed January 14, 2002; a Supplemental IDS filed July 6, 2001 and an Information Disclosure Statement and Supplemental Preliminary Amendment filed May 29, 2002.

As can be seen in the enclosed computer printout, a Notice of Allowability is set forth with a "Base" of September 4, 2003; however, this is the copy of the Notice of Allowability attached to the Notice of Allowance mailed December 18, 2001, transmitted by the Examiner to the offices of the undersigned on September 4, 2003. As can be seen from the enclosed printout, there is no indication of receipt of a Notice of Allowance mailed December 18, 2001, around December 18, 2001.

For the Notice of Allowance mailed December 18, 2001, the expiration date of a non-extendable statutory period for payment of the Issue Fee would be March 18, 2002. Therefore, if the Notice of Allowance mailed December 18, 2001, had been received in the offices of the undersigned attorney, the docketing department would have added "Issue Fee" under "Action"; a "Base" of December 18, 2001; a "Due" of March 18, 2002; and a "Final" of March 18, 2002. However, as can be seen from the attached printout, this is not set forth, indicating that the Notice of Allowance mailed December 18, 2001, was never received in the offices of the undersigned attorney.

Furthermore, as a safety cross check against the computer database, the docketing department maintains a handwritten master docket book which has one page for each day of the year.

After data relating to a PTO paper has been entered into the computer database, the docketing department handwrites data relating to such paper into the master docket book on the page corresponding to the expiration date of a maximally-extended statutory period for response to the paper. As discussed above, for the Notice of Allowance mailed December 18, 2001, the expiration date for payment of the Issue Fee would be March 18, 2002.

Attached hereto is a copy of the master docket book for March 18, 2002. When the Notice of Allowance is received, the docketing department enters the following information in the master docket book on the page corresponding to the expiration date of the last possible date for response: the docket number of an application to which the PTO action pertains; the last name of the first-named inventor of the application; the

serial number of the application; the notification "Issue fee" and, if also due, "pub fee" (for publication fee); and the initials of the attorney to whom the application is assigned.

Therefore, if the Notice of Allowance mailed December 18, 2001 had been received in the offices of the undersigned attorneys, the attached copy of the page of the master docket book for March 18, 2002 would show an entry with the following data: docket no. 520.30414V22; the last name "Kato"; Serial No. 766,596; the notation "Issue Fee" and "pub fee"; and the initials "WIS". However, as can be seen from the attached copy of the page of the master docket book for March 18, 2002, such an entry does not appear.

While entries for related applications (Serial No. 780,394; No. 781,452; and No. 780,427) do appear, it is again emphasized that there is no entry for Serial No. 766,596.

It is respectfully submitted that the absence of entries on the master docket book page for March 18, 2002, further evidences the fact that the Notice of Allowance mailed December 18, 2001 was never received in the offices of the undersigned attorney.

It is again noted that the copy of the Notice of Allowance mailed December 18, 2001, sent to the offices of the undersigned on September 4, 2003 by the Examiner, has a mailing address to the following:

Mitchell P Brook  
c/o Baker & McKenzie  
101 Broadway  
Suite 1200  
San Diego, CA 92101,

and a customer service number of 024057. Clearly, the U.S. Patent and Trademark Office erred in mailing the Notice of Allowance on December 18, 2001 to an incorrect address, and in setting forth an incorrect customer service number for the above-identified application; and it is likely that these errors by the U.S. Patent and Trademark Office were the cause of the failure of the Notice of Allowance to be received in the offices of the undersigned.

It is noted that, as seen on the enclosed computer records for the above-identified application, various papers have been filed in the above-identified application after December 18, 2001; and, in fact, after March 18, 2002. For example, a Supplemental Preliminary Amendment was filed January 14, 2002; Information Disclosure Statements were filed February 6, 2002, July 16, 2002 and February 20, 2003; and another Supplementing Preliminary Amendment was filed March 13, 2003. It is respectfully suggested that the U.S. Patent and Trademark Office should have, prior to September 4, 2003, notified Applicants that the Notice of Allowance had been mailed December 18, 2001. Furthermore, it is also noted that Applicants have never received a Notice of Abandonment in the above-identified application. It is respectfully submitted that the present Petition is timely, particularly in light of failures and errors by the U.S. Patent and Trademark Office, in failing to notify Applicants of the Notice of Allowance mailed December 18, 2001, until September 4, 2003, and is still not notifying Applicants (e.g., by a Notice of Abandonment) of the abandonment of the above-identified application.

Furthermore, upon a full review by the undersigned of the file of the above-identified application that is in the offices of the undersigned, it is hereby stated by the

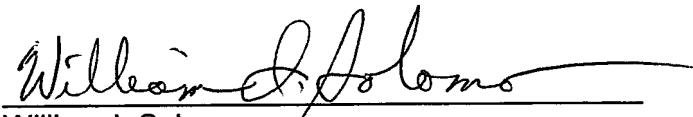
undersigned that a copy of the Notice of Allowance mailed December 18, 2001, other than a copy thereof sent to the undersigned by the Examiner on September 4, 2003, is not in the application file.

For reasons discussed above, it is respectfully submitted that the Notice of Allowance and Fee(s) Due mailed December 18, 2001, was never received in the offices of the undersigned attorney. Accordingly, pursuant to Manual of Patent Examining Procedure 711.02 and under the rationale set forth in Delgar, Inc. v. Schuyler, 172 USPQ 513 (DDC 1971), it is respectfully petitioned that any holding of abandonment be withdrawn, and that a new Notice of Allowance be issued with a mailing date of the date of actual mailing of the new Notice of Allowance, and that all papers having been filed in the above-identified application before the date of mailing of the new Notice of Allowance be entered in and considered in the above-identified application as a matter of right.

To the extent necessary, Applicants petition for an extension of time under 37 CFR § 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account No. 01-2135 (Case No. 520.30414V22), and please credit any excess fees to such Deposit Account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP



William I. Solomon  
Registration No. 28,565

1300 North 17<sup>th</sup> Street  
Suite 1800  
Arlington, VA 22209  
Tel: (703) 312-6600  
Fax : (703) 312-6666  
WIS:sgj

OPER	WSM	ENTERED	11/30/2000	MODIFIED	9/4/2003	ATTORNEYS	WIS	/	WIS	/	DKT	PRINTED ON:	9/10/2003
ATSK#	520.30414V22	CNTRY	US	UNITED STATES		NEW/CON	CON	RELATED	503.30414C19				
PATS#	P16787USB	TYPE	UTL	SERIAL#	09/766,596	PATENT#		STAT	PENDING				
TITLE	VACUUM PROCESSING APPARATUS AND OPERATING METHOD THEREOF***LET WIS KNOW WHEN IF COMES IN***										RL/FM		
CLIENT	520	NITTO IPO LTD.		1	CREF	NTT045US-25	SE		ART				
AGENT					AREF		CLAIMS			00221906			
PRIOR		MAIL	1/23/2001	FILE	1/23/2001	PUBL		ISSUE	EXP	10/23/2018	1ST	10/23/1998	

ID	O	ACTION	BASE	DU IN	DU	EXTNS	FINAL	EXT	RESPONSE	CALL	1	2	P
PC	N	POST CARD CHECK	1/23/2001	1 M	2/23/2001		2/23/2001	0	2/5/2001	0 M	N	N	Y
	Y	IDS/SUPP PRELIM FLD	5/29/2001										
	Y	SUPPL IDS FILED	7/6/2001										
	Y	SUPP PRE AMEND FILED	1/14/2002										
	Y	IDS FILED	2/6/2002										
ID	N	IDS DUE	7/16/2002	0 M	7/16/2002		7/16/2002	0	7/15/2002	1 M	Y	Y	N
	y	ids filed	2/20/2003										
	Y	SUPPL PRELIM AMNDT	3/13/2003										
	Y	NOT OF ALLOWBILTY	9/4/2003										
SENT BY FAX BY EXAMINER													

PRIOR APPLICATIONS												
REFERENCE#	CNTRY	SERIAL#	FILED	TITLE / DESCRIPTION								TYPE
503.30414C19	US			VACUUM PROCESSING APPARATUS AND OPERATING METHOD THEREOF								APPL

#### NOTES

12/04/01 FAX/COMMS/INSTR  
 01/17/02 LTR/COMMS/INSTR  
 03/26/02 FAX/COMMS  
 04/18/02 FAX/COMMS RE EXAM RESULTS  
 12/27/02 FAX/FILE IDS-NO DUE DATE  
 1/16/03 FAX/FILE IDS-NO DUE DATE  
 1/17/03 LTR/CONFIRM FAX  
 2/10/03 FAX/COMMS  
 2/13/03 LTR/CONFIRM FAX  
 02/19/03 FAX/AMEND CLAIMS  
 2/25/03 LTR/CONFIRM FAX  
 2/27/03 FAX/COMMS/INSTR  
 3/4/03 LTR/CONFIRM FAX  
 3/17/03 FAX/COMMS  
 3/24/03 LTR/CONFIRM FAX  
 8/1/03 FAX/COMMS  
 8/4/03 CCOMMS  
 8/5/03 LTR/CONFIRM FAX  
 8/22/03 FAX/COMMS/FILE 2 DIV APPS  
 9/2/03 LTR/CONFIRM FAX  
 9/4/03 FAX/FILE 2 DIV APPS

2002 27th day 239 days  
2003 12th day 31 days  
O P E  
SEP 12 2003  
PAPER

MONDAY 18 MARCH

1055.3923X00 4956064 maine AF5 bm plome  
525.26738X00 4957350 maine AK  
321.26876X00 4957581 maine AES other  
520.37757X00 ~~Yoshage~~ 491093 Region Ecp CTS 118  
520.37152X00 ~~Kobayashi~~ 490012 Region Ecp CTS 118  
523.37887X00 ~~Yam~~ 491050 Region Ecp MK 118  
520.37555X00 ~~Yokoyama~~ 385401 Region Ecp CTS  
500.35377X00 ~~Yasai~~ 4003907 Region Ecp MK  
501.36909X00 ~~Suzuki~~ 3442303 AF5 Ecp 2015 → 3118  
500.40557X00 ~~Sada~~ 493761 ~~deaf~~ Ecp SEM  
500.40528X00 ~~Kagayama~~ 4938113 ~~deaf~~ Ecp MK 9/29  
843.30512X00 ~~Munami~~ 768471 ~~Deaf~~ Ecp SEM 10/18  
503.35787X02 ~~Uchimamoto~~ 8341876 Ection Ecp MK APC  
612.40914X00 ~~Utility~~ 4742100/EC IDS due DES  
912.40887X00 ~~Bailey~~ 4111113/EST IDS due 0MB  
500.21231123X00 ~~DRAFT DUE~~ AC 35434 DES V  
520.30414V30 ~~Kato~~ 780394 ~~purple~~ WIS  
" " " ~~purple~~ WIS  
520.30414V35 ~~Kato~~ 780452 ~~purple~~ WIS  
" ~~purple~~ WIS  
520.30414V28 ~~Kato~~ 780427 ~~purple~~ WIS  
" ~~purple~~ WIS  
500.33011C8 ~~Taketuma~~ 7110251 ~~purple~~ SEM  
501.320885ext ~~Sanguchi~~ 8185106 ~~purple~~ SEM  
561.370220C2 ~~Fujisawa~~ 907959 ~~purple~~ SEM  
" ~~purple~~ SEM  
500.38996X00 ~~Orano~~ 654890 ~~purple~~ MK ~~not need~~  
" ~~purple~~ MK ~~not need~~  
501.337459X2 ~~Maeda~~ 58820 ~~purple~~ PS 3118  
" ~~purple~~ PS 3118  
501.345931V3 ~~Hash.~~ 835419 ~~purple~~ WIS  
" ~~purple~~ WIS  
501.37013X00 ~~Sayama~~ 272784 ~~purple~~ MK  
520.35502ext ~~Ochiai~~ 6014773 ~~purple~~ PS 3118  
520.37873X00 ~~Miyano~~ 4372107 ~~purple~~ SEM  
501.35293V2 ~~Dogu~~ 884378 ~~purple~~ WIS  
" ~~purple~~ WIS  
519.37826ext ~~Murahashi~~ 8418423 ~~purple~~ AF5 180  
503.30918X00 ~~Muramatsu~~ 340109 ~~purple~~ CTS/1993

200 01 P E 31 M 02

SEP 1 2 2003

100

058	01. 38176X00	call erron, abandon	dest rmb ✓
525.	520. 37813X1	file cont app	gem
321	520. 33229X1	form draws leaf app	CIBS✓
20. 3	501. 33916X00	IDS	MLK ✓
20. 3	501. 37022X2	file cont app	CIBA
20. 35	503. 36914X2	file draw app	MLK ✓
21. 36	520. 37552X00	file dw app	MLK ✓
20. 40	501. 33745X2	file cont app	318 P3
20. 41	5160. 35510X1	file cont app	318 P3
21. 30	520. 383107X06	file cont app	318 MLK ✓
23. 36	501. 38338X00	file cont app	CIB 318
12. 40	367. 37305X00	draft resp	318 MLK ✓
24. 40	503. 35933X1V1	file cont	WIS 313
20. 3	503. 35933X1V+	file cont	WIS 313
20. 31	017. 41085X00	Appen dw	Dest RMB 314
2. 304	501. 36560X2	file dw app	gem ✓
337	199. 41489X00	WISWELL	call up 220181 1st draft DES 120 ✓

35293

30909 going late

Aug  
3/18/52

→ not need  
introduction

118

18

37013X00	Sayma	272784	Passenger	10/15
35500X00	Batumi	604773	Passenger	10/18
37813X00	Mgano	437267	Passenger	8/15
35293X02	Dgno	884378	Passenger	10/15
"	"	"	Passenger	10/15
37822X01	Fruchani	8418723	Passenger	10/15
310918X00	Muramatsu	3600109	Passenger	03/1993
"	"	"	Passenger	03/1993
310310X00	Shandar	091419	Passenger	10/15
"	"	"	Passenger	10/15
038361X00	Miyata	546515	Passenger	10/15
033289CC4	"	"	Passenger	10/15
310307X00	Sano	0916154	Passenger	10/15
"	"	"	Passenger	10/15
5. 310410PA	DAGIN	8104168	Passenger	03/1993
6. 310607X02	"	"	Passenger	03/1993